

for several reasons. First, independent claim 1 recites a position measuring system that includes a wall having an integral deformation. While the Examiner at page 2 of the Office Action identified aperture 67 as an opening of the cover 64 that defined a deformation, the Examiner at page 4 of the Office Action conceded that Ernst did not disclose a deformation that was integral with cover 64.¹ The Examiner appears to be asserting that it would have been obvious to have the bushing located between the cable cord 66 and the aperture 67 be integral with the cover 64. At page 4 of the Office Action, the Examiner has relied on *Howard v. Detroit Stove Works* for the proposition that “it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.” The reliance on *Howard* is misplaced since *Howard* was decided over fifty years prior to the enactment of 35 U.S.C. § 103 in 1952 and so its applicability to the present case is questionable. In addition, the statement relied on by the Examiner is at best dicta since the third patent in question was held to be anticipated and there appeared to be no issue in the discussion of the prior art that the claims recited one piece while the prior art disclosed separate pieces. Even if *Howard* is applicable to the present case, it does not contradict the fact that there must be a showing in the present rejection that it would have been obvious to one of ordinary skill in the art to alter Ernst to have its cover 64 include an integral deformation per *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Such showing must be explicit per *KSR Int’l Co. v. Teleflex, Inc.*, No. 04-1350 550 U.S. ____ (Apr. 30, 2007). With that said, there has been no explicit showing in the present rejection that it would have been obvious to alter Ernst to have its cover include an

¹ The Examiner asserts at page 2 of the Office Action that the opening 67 shows an alteration to its shape and form. Applicant disagrees in that Ernst does not mention a deformation and the drawings do not show a deformation, i.e., a comparison of the opening 67 with cable cord 66 present and with cable cord 66 absent. Without any disclosure by Ernst, the Examiner’s assertion is based on pure speculation which is improper.

integral deformation and so the rejection is improper and should be withdrawn.

Assuming for argument's sake only that one of ordinary skill would interpret the cable bushing shown in FIG. 6 to be an elastic material that seals the space between the cover 64 and the cable cord 66 in the opening 67², it would not have been obvious to have the cover 64 and the cable bushing integral with one another since the cover is made of an inelastic rigid material and the bushing is made of an elastic resilient material. Having the cable bushing made of an inelastic rigid material would result in the housing deforming in the area of the opening defined by the inelastic bushing due to the movement of the cable cord 66 which is of course undesirable. Due to such a teaching away from the claimed invention, the rejection is improper and should be withdrawn. *In re Chu*, 66 F.3d 292, 298, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995).

The rejection is improper for the additional reason that Ernst does not disclose that the cable cord 66 has a shield around signal lines for preventing electro-magnetic interference. The Examiner at page 4 of the Office Action conceded that Ernst does not disclose such a shield. To overcome the deficiencies of Ernst, the Examiner relied on the Diep patent. In particular, the Examiner at page 4 of the Office Action suggested replacing the cover material of cord 66 that covers the three electrical lines with Diep's metal shield 30. Assuming for argument's sake only that such a replacement would be permissible, it still would not render claim 1 obvious because claim 1 requires that the deformation bind the shield to the housing "so as to provide a secure electrical contact between said shield and said housing." Diep teaches away from having its metal shield 30 from forming a secure electrical contact with a housing. For example, Diep discloses that

² It appears that Applicant's Amendment of September 18, 2006 inadvertently failed to make it clear that Applicant was not admitting that the bushing of Ernst was elastic. That error is being corrected herein.

“[t]he shield 30 is typically surrounded by plastic or rubber insulation 32 to provide protection to the shield 30 and wires 28” (Col. 2, ll. 44-46). Using plastic or rubber insulation with shield 30, as required by Diep, would prevent an electrical contact between shield 30 and the cover 64 of Ernst should the Examiner’s suggested replacement be made. This teaching away by Diep is evidence that the rejection is improper and should be withdrawn.

The rejection of claim 6 is improper for the additional reason that there is no suggestion in Ernst to use an adhesive provided in the opening between the cable cord 66 and the cover 64. The Examiner at pages 5 and 6 of the Office Action appears to be saying that it would have been obvious to replace the bushing with an adhesive. Such a replacement misses the point. The invention of claim 6 requires that the deformation and the adhesive are present. Since there is no explicit analysis given in the Office Action to use both an integral deformation and an adhesive in Ernst, the rejection is improper and should be withdrawn.

The rejection of claim 7 is improper for the additional reason that there is no suggestion in Ernst to use an intermediate ply provided in the opening between the cable cord 66 and the housing. The Examiner at pages 5 and 6 of the Office Action appears to be saying that it would have been obvious to replace the bushing with an intermediate ply. However, the invention of claim 7 requires that the deformation and the intermediate ply are present. Since there is no explicit analysis given in the Office Action to use both an integral deformation and an intermediate ply, the rejection is improper and should be withdrawn.

It is noted that the Examiner in the Office Action has failed to provide any reasoning to use the adhesive or intermediate ply recited in claims 6 and 7. Such conclusory reasoning is improper per *KSR*.

It is noted that the Examiner cited *In re Leshin* at page 6 of the Office Action for the proposition that the material of claims 6 and 7 would have been obvious based on Applicant's intended use for the material. This is an improper standard in that it relies on Applicant's own intended use for his own invention to provide motivation to reject the claims. This is a clear instance of improper hindsight being used to reject the invention. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). Such hindsight reasoning is improper per *KSR*. Furthermore, such intended use has at best a date of establishment of April 9, 2004, the filing date of the present application, while 35 U.S.C. § 103 is limited to evidence prior to Applicant's filing date.

2. Ernst and Schneider et al.

Claims 2-5 and 8 were rejected under 35 U.S.C. § 103 as being obvious in view of Ernst and Schneider et al. Claim 2 depends directly on claim 1. As mentioned above in Section A.1, Ernst fails to disclose having its cover include an integral deformation and to use a shielded cable having a shield which prevents electro-magnetic interference and forms an electrical contact with a housing. Since there has been no reasoning from Schneider et al. or other sources to alter Ernst's wall to include an integral deformation and to use a shielded cable having a shield which prevents electro-magnetic interference and forms an electrical contact with a housing, the rejection is improper and should be withdrawn.

It is noted that the Examiner at page 7 of the Office Action asserted that Schneider et al.'s cable has a shield as recited in claim 1. While Schneider et al. does disclose a shield 144, Schneider et al. uses a connector 170 to attach electric cable 140 to chassis 130. There is no discussion in Schneider et al. or other sources to use an integral deformation as recited in claim 1. Accordingly, the rejection is improper and should be withdrawn.

Applicant traverses the rejection of claim 8 in that neither Ernst nor Schneider et al. nor other factors disclose or suggest using the recited elastic intermediate ply that is "provided in said opening between said shielded cable and said housing." The Examiner has failed to provide any reasoning to use the recited elastic intermediate ply. Examiner attempts to overcome this deficiency by relying on *In re Leshin*. This reliance is misplaced for reasons similar to those given above in Section A.1.

CONCLUSION

In view of the arguments above, Applicant respectfully submits that all of the pending claims 1-11 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, she is respectfully requested to contact the undersigned attorney at (312) 321-4200.

Respectfully submitted,



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